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| 09/711,194 | 11/13/2000 | Casey William Norman | 1391-CIP-00 | 6427 |

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EXAMINER

WILLIAMS, JAMILA O

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3712

DATE MAILED: 03/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,194

Applicant(s)

NORMAN ET AL.

Examiner

Jamila Williams

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,227,930 in view of Gross.

The patented and the pending claims set forth the same invention of substantially the same scope except the invention of patented claims 1-11 lacks a skin in a form selected from the group consisting of animal, human, monster, super hero, robot, and cartoon character, as recited in claim 9. (applicant discloses on page 4 line 20 of the specification that the garment is a skin). Gross discloses a skin in the form of a human and animal (figures 22 and 53 respectively). In view of Gross, it would have been obvious to one of ordinary skill in the art to modify the patented doll's garments of claims 1-11 by providing a skin in the form of an animal or human in order to give the doll a more versatile appearance.

With regards to claims 8 and 10 and 15, the applicant shows no criticality as to the size of the doll (page 10, line 18 of the specification), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the size of the skin in order to provide a varied appearance for any number of dolls.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

4. The disclosure is objected to because of the following informalities: Throughout the specification there are no reference numbers indicating the applicants invention. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, it is unclear what the applicant intends to claim. It appears from the preamble of claim 5, that the applicant intends

- to place further structural limitations on "the garment", however in claim 4 (which claim 5 is depending from) the preamble it directed towards a doll's skin.
7. Claim 1 recites the limitation "the skin" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.
 8. Claim 5 recites the limitation "the garment" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.
 9. Claim 11 recites the limitation "the seamless garment" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.
 10. Claim 13 recites the limitation "the material" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.
 11. Claim 17 recites the limitation "the garment material" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. The claims are replete with errors of this nature. The examples given above are intended for the applicant to make corrections where appropriate but not limited to those listed.
 12. With regards to claims 10 and 15, the use of the phrase "life-like manner" renders the claims indefinite because the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Note: Since the present invention is a continuation in part, applicant is entitled to an effective filing date of 4-23-98 for the common subject matter in the invention. The Gross reference is also a continuation in part and therefore is entitled to an effective filing date of 5-26-95.

14. Claims 1-3 and 9, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by '708 to Gross. Gross discloses a doll skin (flexible, elastic skin 90) molded in at least one part from an elastomeric material (column 28 lines 6-8 of the specification), the method of molding (figs 34-36b), seamless (column 14 lines 25-27), wherein the elastomeric material is a synthetic polymer (latex elastomer, column 28 line 8). Gross further discloses that the skin is in a form (animal form, fig. 53). Inasmuch as the skin of Gross meets all of the structural limitations of the claims, it is inherently capable of performing all of the claimed functions.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4-5 rejected under 35 U.S.C. 103(a) as being unpatentable over '708 to

Gross in view of '804 to Nakashima. Gross includes all of the limitations as applied to claims above, except for the teaching of the skin being a copolymer. Nakashima teaches a color change material (fig 1) having a reversibly thermochromic layer and a porous layer for use in dolls, doll clothes, and doll accessories. Nakashima further teaches the use of ethylene vinyl acetate copolymer in the material (column 4 lines 30-36 of the specification). It would have been obvious to one of ordinary skill in the art to incorporate the skin of Gross with the copolymer of Nakashima for the purpose of providing a more flexible covering for the doll.

Conclusion


17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not use to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 703-305-3312. The examiner can normally be reached on Monday-Friday from 6:30a.m to 3:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks, can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3579.

Art Unit: 3712

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


DERRIS H. BANKS
PRIMARY EXAMINER
SPE 3712